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10/672,645

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Kirk A. Buhler

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06/28/2005

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EXAMINER

JULES, FRANTZ F

ART UNIT

PAPER NUMBER

3617

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/672,645

Applicant(s)

BUHLER ET AL.

Examiner

Frantz F. Jules

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the recitation of "a third cover member connected with a bearing to the first or second member" in claims 6 and 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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***Specification***

2. The disclosure is objected to because of the following informalities:

The specification fails to disclose to an ordinary skill in the art how to construct an outer member which is made from a material consisting of metal, plastic and rubber as recited in claims 4 and 11.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, lines 1-2, the phrase "a group of materials consisting of ball bearings, plastic bearings and bronze bearings" is confusing as ball bearings are not a material.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7-8 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Whiteman (US 2,997,344).

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Whiteman discloses a wheel cover for a vehicle comprising an inner member 13 with an attachment mechanism for connecting to a vehicle rim as discloses in col 1, lines 69-70, at least one outer member (33) that is not eccentrically weighted, a bearing mechanism (30) that connects the inner member to the outer member to allow the members to turn independently from each other since during operation of the vehicle, the inner member 13 will turn with the direction of the wheel while the outer member 31 is free to turn in the opposite direction. The outer member is located on or off axis from the axis of the inner member as shown in fig. 2-3

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 5, 7-9 and 14 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Good (US 2004/0075332 A1).

Good discloses a wheel cover for a vehicle comprising an inner member (16) with attachment mechanism (18) for connecting to a vehicle rim, at least one outer member (12) that is not eccentrically weighted, a bearing mechanism (22) that connects the inner member to the outer member to allow the members to turn independently from each other as disclosed in the abstract. The outer member is located on the axis of the inner member as shown in fig. 2-3.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2, 4-6, 9, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteman (US 2,997,344) in view of Wallach (US 6,820,475).

**Claims 2 and 9**

Whiteman teaches all the limitations claims 2 and 9 except for a wheel cover comprising an attachment mechanism consisting of clips or springs. The general concept of providing an attachment mechanism consisting of spring and clips to a wheel cover is well known in the art as illustrated by Wallach which discloses the teaching of clips or springs (24) to locate a wheel cover, see fig. 2. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteman to include the use of an attachment mechanism comprising springs or clips in his advantageous wheel cover as taught by Walach in order to facilitate installation of the wheel cover thereby removing the risk of personnal injury.

**Claims 4-5, 11-12**

Regarding using an outer member made of a material consisting of metal, plastic and rubber and bearings made from ball bearings, plastic bearings and bronze bearings as recited in claims 4-5 and 11-12, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteman to include the use of an outer

member made of a material consisting of metal, plastic and rubber and bearings made from ball bearings, plastic bearings and bronze bearings in his advantageous system, as material selection is a common and everyday occurrence throughout the wheel cover design art and the specific use of an outer member made of a material consisting of metal, plastic and rubber and bearings made from ball bearings, plastic bearings and bronze bearings would have been an obvious matter of design preference depending upon such factors as the wind loading imposed on the wheel cover, the maximum speed of the vehicle, the yield strength of the bearing and the outer member; the ordinarily skilled artisan choosing the best stress profile corresponding to a particular loading imposed on the wheel cover which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

#### Claims 6 and 13

Regarding using a third cover member connected with the bearing to the inner and outer member as recited in claims 6 and 13, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteman to include the use a third cover member connected with the bearing to the inner and outer member in his advantageous system, as the duplication /reduction of identical parts which perform essentially the same function is a common occurrence throughout the wheel cover design arts, and the specific number of cover member used on a wheel cover would have been an obvious duplication of parts, depending upon such common factors as the

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loading imposed on the wheel cover, the yield strength of the bearing and cover material, the weight of the wheel cover; the ordinarily skilled artisan choosing the best number of cover members which would most optimize the cost and performance of the device for a particular application at hand, based upon the above noted common design criteria.

11. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiteman (US 2,997,344) in view of Miyanaga (US 3,367,722).

Whiteman teaches all the limitations claims 3 and 10 except for a wheel cover comprising an attachment mechanism consisting of one or more magnets. The general concept of providing an attachment mechanism consisting of one or more magnets to a wheel cover is well known in the art as illustrated by Miyanaga which discloses the teaching of one or more magnet (84') to locate a wheel cover (52), see fig. 3, col 2, lines 40-48. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Whiteman to include the use of an attachment mechanism comprising one or more magnets in his advantageous wheel cover as taught by Miyanaga in order to simplify installation of the wheel cover thereby removing the risk of personal injury.

### ***Response to Arguments***

12. Applicant's arguments filed 05/10/2005 have been fully considered but they are not persuasive.

A. Summary of applicant's argument



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In the amendment, applicant traversed the rejection of the newly amended claims for the following reasons:

1. The reference cited in the 102 rejection, Whiteman, fails to meet the all of the criteria of anticipation since "Whiteman discloses the outer hub cap (13) col 1, lines 6+69 attaches to the vehicle rim (13') and that the inner spinning hub (31) col 2, lines 20-22 is locate between the outer hub cap and the vehicle rim as shown in the cross sectional view, figure 2. In the pending application, the second or spinning member is located on the outside of the member that is attached to the vehicle rim. This is the opposite configuration patented and disclosed by Whiteman".
2. The reference cited in the 102 rejection, Wang, is not a proper reference under 102 b.
3. There is no teaching or suggestion in Whiteman to provide a second or additional spinning members.
4. The combination rejection of Whiteman and Schurig is improper since Schurig does not disclose using magnet to attach the hub cap to the vehicle rim.

**B. Response to applicant's argument**

1. Regarding applicant's argument number 1, it should be noted that the Whiteman reference teaches all the limitations of claims 1, 7-8 and 14 as explained above.

Applicant's argument that "Whiteman discloses the outer hub cap (13) col 1, lines 6+69 attaches to the vehicle rim (13') and that the inner spinning hub (31) col 2, lines 20-22 is locate between the outer hub cap and the vehicle rim as shown in the cross sectional

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view, figure 2. In the pending application, the second or spinning member is located on the outside of the member that is attached to the vehicle rim. This is the opposite configuration patented and disclosed by Whiteman" is weak since the first member 13 of the Whiteman reference will turn independently from the second member 33 during operation of the vehicle.

2. Applicant's argument number 2 is moot in light of the fact that the rejection over the Wang reference has been substituted by the Good reference.

3. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, an ordinary skill in the art would have been motivated to incorporate a second or additional spinning members to the wheel cover of Whiteman in order to achieve among others the benefit of improving the aesthetics of the wheel.

4. Applicant argument NO. 4 is moot in light of the face that the rejection of claims 3 and 10 over the Scurig reference has been replaced by the Miyanaga reference.

### **Conclusion**

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz F. Jules whose telephone number is (703) 308-8780. The examiner can normally be reached on Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph S. Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frantz F. Jules  
Primary Examiner  
Art Unit 3617

FFJ

June 21, 2005

**FRANTZ F. JULES**  
**PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read 'Frantz F. Jules', written over a horizontal line.